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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/046,709

Applicant(s)

HATAKEYAMA, EIICHI

Examiner

MICHAEL R. ZECHER

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 & 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. The following is a second, non-final Office Action on the merits. The Amendment/Remarks received on May 10, 2007, have been entered. **Claims 1-9, 11, 13-18, & 20** have been amended. **Claim 19** has been cancelled. **Claims 1-18 & 20-23** are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1-18 & 20-23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "estimation," "judging," and "forecasting" in **claims 1, 5, 15, & 20** are relative terms which render the claims indefinite. The terms "estimation," "judging," and "forecasting" are not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 2-14 depend from claim 1 and therefore contain the same deficiency.

Claims 16-18 depend from claim 15 and therefore contain the same deficiency.

Claims 21-23 depend from claim 20 and therefore contain the same deficiency.

4. **Claim 13** recites "the consolidated beneficiary right transferred from the fund donor is an object of a pension fund management contract between the fund donor and a trust and banking company by the financial institution." It is unclear what this

limitation entails. Clarification is required. For examination purposes, the Examiner has construed the limitation as --a transferred intellectual property right that is an asset of a business--.

5. **Claim 14** recites "the consolidated beneficiary further includes a beneficiary right on the basis of securities with stock instrument included issued by the entrepreneur." It is unclear what this limitation entails. Clarification is required. For examination purposes, the Examiner has construed the limitation as --an investor can designate a beneficiary--.

Claims 16, 18, 21, & 23 recite equivalent limitations to claim 14 and are therefore rejected using the same rationale set forth above.

6. **As per claims 15-18**, various "means for" are claimed, but there is no support for their corresponding structure in the specification, as required by § 112, 6th paragraph. The Examiner requests Applicant to either particularly point out the corresponding structures in the specification or remove the "means for" language.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 15-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 15 fail to place the invention squarely within one statutory class of invention. In the preamble, applicant has provided evidence that applicant intends to claim a "server." As such, the claim is drawn to a non-statutory invention. A server is

not one of the four categories of invention and therefore this claim is not statutory. A server is not a series of steps or acts and thus is not a process. A server, by itself, is not a physical article or object that constitutes a machine or manufacture. A server is not a combination of substances and therefor not a composition of matter.

Claims 16-18 depend from claim 15 and are therefore rejected under the same rationale set forth above.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-3, 5-18, & 20-23** are rejected under 35 U.S.C. 102(e) as being anticipated by Elliott (U.S. 2001/0042034).

As per claim 1, Elliott teaches a method of investment management for managing an investment to a business to be performed by an entrepreneur using an intellectual property right, comprising the steps of:

storing information about a consolidated beneficiary right in a first server computer, wherein the consolidated beneficiary right is based on acceptance of stocks of the entrepreneur and a trust of the intellectual property right transferred from the entrepreneur to a fund donor in exchange for funds to be provided to the business and

supplied by the fund donor (See paragraph 61 and claim 27, which discusses storing selected data regarding transfer of funds, payment, general trust accounts, and a portfolio containing at least two intellectual properties); and

performing an income estimation about the investment to the entrepreneur at the first server computer on the basis of the information about the consolidated beneficiary right stored in the first server computer and information about proceeds of the business of the entrepreneur received from a first client computer, the information about proceeds including a profit on sale of the stocks and amounts of royalties (See paragraphs 27, 49-58, & 67, and claim 31, which discusses performing an estimation based on securitization of intellectual property, including tracking royalty payments and taking into account a portfolio that includes at least one security instrument),

wherein the performing step includes:

accumulating the received amounts of royalties (See paragraph 55-56 & 207-217, which discusses recording royalty payments received);

judging an expiration of the trust by comparing the accumulated amounts of royalties with predetermined amounts (See Figure 1 and paragraphs 133-143, which illustrates and discusses analyzing royalties in an investment trust); and

forecasting sales proceeds of the goods produced by the entrepreneur's enterprise at least on the basis of the received information about proceeds of the business of the entrepreneur so as to terminate the trust related to the consolidated beneficiary right by selling the stocks when reduction of sales proceeds is expected or the entrepreneur began over-the-counter trading even if it is judged in the judging step

that the accumulated amounts of royalties do not fulfill expiration conditions of the trust (See Figure 1 and paragraphs 34 & 207-258, which illustrates and discusses predicting a patents present and future value in order to decrease the risk involved in the creation of a securitized financial derivative).

As per claim 2, Elliott teaches wherein the consolidated beneficiary right includes a beneficiary right to receive the royalty related to the intellectual property right whose name is transferred to the fund donor based on acceptance of the trust (See paragraphs 133-143, which discusses how an investor receives specified payments during the term of the trust).

As per claim 3, Elliott teaches notifying to the first client computer that processes the information about the entrepreneur before the trust of the intellectual property right is transferred from the entrepreneur to the fund donor (See paragraphs 23 & 93-99, which discusses creating and identifying investor accounts; and, furthermore, indicators based on an intellectual property portfolio being securitized), wherein the notifying step including the steps of:

the first server computer receives an application for financing to the business of the entrepreneur from the first client computer (See paragraphs 23 & 93-99, which discusses identifying one or more investors), and

the first server computer transmits notice information chosen from two or more notice information for notifying a corresponding examination result about the application to the first client computer, wherein the two or more notice information for notifying the respective examination results is previously stored in the first server computer (See

paragraphs 23, 49-58, 116, and claim 27, which discusses creating and identifying one or more investor accounts and transactions whereby the respective information is stored and transmitted).

As per claim 5, Elliot teaches wherein the step of performing the income estimation includes the step of calculating an estimated amount of the income to be brought from the entrepreneur using the received amounts of royalties (See paragraph 23, which discusses obtaining an amount from an investor in exchange for an assignable agreement to allocate a proportionate amount of future income accordingly).

As per claim 6, Elliott teaches wherein the intellectual property right transferred from the entrepreneur to the fund donor is related to a trust instrument and is a target property of the trust accepted by the fund donor (See paragraph 22, which discusses transferring intellectual property rights in correlations with an assignable investment instrument).

As per claim 7, Elliott teaches wherein the first server computer takes charge of an income obtained by means of the consolidated beneficiary right as reinvestment capital funds for another business to circulate the income (See paragraphs 49-58, which discusses how the system manages the transfer of monetary funds).

As per claim 8, Elliott teaches wherein acquisition of the stocks and sponsorship for the entrepreneur on the basis of acceptance of the intellectual property right are based on an equity instrument and a trust agreement with the entrepreneur, and is performed based on a fund that is established by the fund donor (See claims 1, 7, & 12,

which discusses the correlation between intellectual property rights, security instruments and trust agreements based on financing provided by an investor).

As per claim 9, Elliott teaches storing sales information about a financial product in a second server computer that processes information about a financial institution that supplies the financial product that is made from the consolidated beneficiary right transferred from the fund donor by means of processes of liquidating and securitizing an asset; and transmitting the sales information stored in the second server computer to a second client computer that processes information about an investor (See Figure 4, paragraphs 46 & 61, and claim 27, which illustrates and discusses storing selected data regarding funds, payment, etc. pertaining to investors).

As per claim 10, Elliott teaches receiving information on purchase application from the second client computer by the second server computer, wherein the purchase application is provided for the purchase of a financial product represented by the sales information transmitted from the second client computer to the second server computer (See Figure 4 and paragraph 46, which discusses a computer system necessary to handle multiple investor accounts and numerous transactions, including increasing and withdrawing investment funds); and

transmitting reply that corresponds to the purchase application provided for the purchase of the financial product from the second server computer to the second client computer, wherein the reply is chosen from a plurality of reply information by the financial institute, wherein the plurality of reply information is previously stored in the second server computer for the purchase application (See Figure 4, paragraphs 23, 49-

58, 116, and claim 27, which discusses creating and identifying investor accounts and transactions whereby the respective information is stored and transmitted).

As per claim 11, Elliott teaches trust of a financial commodity based on the consolidated beneficiary right transferred from the fund donor is complemented by a priority beneficiary right (See paragraphs 133-139, which discusses the creation of an investment trust in exchange for capital and license back for certain rights in the respective intellectual property).

As per claim 12, Elliott teaches the financial product is a fixed interest security (See paragraph 67, which discusses a security instrument).

As per claim 13, Elliott teaches the consolidated beneficiary right transferred from the fund donor is an object of a pension fund management contract between the fund donor and a trust and banking company by the financial institution (See paragraph 30, which discusses an intellectual property right owned by a third party that relates to product line or business activity).

As per claim 14, Elliott teaches the consolidated beneficiary further includes a beneficiary right on the basis of securities with stock instrument included issued by the entrepreneur (See paragraphs 141 & 142, which discusses how an investor can designate a beneficiary).

As per claim 15, Elliott teaches an investment management server for managing an investment to a business performed by an entrepreneur using an intellectual property right, comprising:

a storage means for storing information about a consolidated beneficiary right based on acceptance of stocks of the entrepreneur and a trust of the intellectual property right transferred from the entrepreneur to a fund donor and supplied by the fund donor in exchange for funds to be provided to the business (See paragraph 61 and claim 27, which discusses storing selected data regarding transfer of funds, payment, general trust accounts, and a portfolio containing at least two intellectual properties); and

a calculation means for performing an income estimation about the investment to the entrepreneur on the basis of the information about the consolidated beneficiary right stored in the storage means and the information about sales proceeds of the business received from a first client computer that processes information about the entrepreneur, the information about proceeds including amounts of royalties (See paragraphs 27, 49-58, & 67, and claim 31, which discusses performing an estimation based on securitization of intellectual property, including tracking royalty payments and taking into account a portfolio that includes at least one security instrument),

wherein the calculating means includes:

accumulating means for accumulating the received amounts of royalties (See paragraph 55-56 & 207-217, which discusses recording royalty payments received);

judging means for judging an expiration of the trust by comparing the accumulated amounts of royalties with predetermined amounts (See Figure 1 and paragraphs 133-143, which illustrates and discusses analyzing royalties in an investment trust); and

forecasting means for forecasting sales proceeds of the goods produced by the entrepreneur's enterprise at least on the basis of the received information about proceeds of the business of the entrepreneur so as to terminate the trust related to the consolidated beneficiary right by selling the stocks when reduction of sales proceeds is expected or the entrepreneur began over-the-counter trading even if the judging means judged that the accumulated amounts of royalties do not fulfill expiration conditions of the trust (See Figure 1 and paragraphs 34 & 207-258, which illustrates and discusses predicting a patents present and future value in order to decrease the risk involved in the creation of a securitized financial derivative).

Claim 16 recites equivalent limitations to claim 14 and is therefore rejected using the same art and rationale set forth above.

As per claim 17, Elliott teaches a storage means for storing a sales information about the financial product (See paragraph 61 and claim 27, which discusses storing date regarding crediting, transferring, and payment to and from accounts, trusts, and portfolios); and

a transmitting means for transmitting the sales information stored in the storage means to a second client computer that processes information about an investor (See figure 4 and paragraph 116, which illustrates and discusses transmitting data to linked programs).

Claim 18 recites equivalent limitations to claim 14 and is therefore rejected using the same art and rationale set forth above.

As per claim 20, Elliott teaches a computer-readable medium capable of configuring a first server computer that manages an investment to a business to be performed by an entrepreneur using an intellectual property right to perform a method of investment management, said method comprising the steps of:

storing information about a consolidated beneficiary right in the first server computer, wherein the consolidated beneficiary right is based on acceptance of stocks of the entrepreneur and a trust of the intellectual property right transferred from the entrepreneur to a fund donor in exchange for funds to be provided to the business and supplied by the fund donor (See paragraph 61 and claim 27, which discusses storing selected data regarding transfer of funds, payment, general trust accounts, and a portfolio containing at least two intellectual properties); and performing an income estimation about the investment to the entrepreneur at the server computer on the basis of the information about the consolidated beneficiary right stored in the first server computer and information about proceeds of the business of the entrepreneur received from a first client computer, the information about proceeds including a profit on sale of the stocks and amounts of royalties (See paragraphs 27, 49-58, & 67, and claim 31, which discusses performing an estimation based on securitization of intellectual property, including tracking royalty payments and taking into account a portfolio that includes at least one security instrument),

wherein the performing step includes:

accumulating the received amounts of royalties (See paragraph 55-56 & 207-217, which discusses recording royalty payments received);

judging an expiration of the trust by comparing the accumulated amounts of royalties with predetermined amounts (See Figure 1 and paragraphs 133-143, which illustrates and discusses analyzing royalties in an investment trust); and

forecasting sales proceeds of the goods produced by the entrepreneur's enterprise at least on the basis of the received information about proceeds of the business of the entrepreneur so as to terminate the trust related to the consolidated beneficiary right by selling the stocks when reduction of sales proceeds is expected or the entrepreneur began over-the-counter trading even if it is judged in the judging step that the accumulated amounts of royalties do not fulfill expiration conditions of the trust (See Figure 1 and paragraphs 34 & 207-258, which illustrates and discusses predicting a patents present and future value in order to decrease the risk involved in the creation of a securitized financial derivative).

Claims 21 & 22 recite equivalent limitations to claims 14 & 17, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 23 recites equivalent limitations to claim 14 and is therefore rejected using the same art and rationale set forth above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (U.S. 2001/0042034), and further in view of Official Notice.

As per claim 4, Elliott does not disclose wherein the profit on sale of the stocks is a profit at the time of going public to over-the-counter.

The Examiner takes Official Notice that it is old and well known to trade financial instruments such as stocks directly between two parties. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Elliott to include calculating profit based on going public to over-the-counter trading in order to present investment opportunities for informed investors at a high degree of risk.

Response to Arguments

13. Applicant's arguments with respect to **claims 1-18 & 20-23** have been considered but are moot in view of the new grounds of rejection.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Martin (U.S. 6,330,547) discloses a method and apparatus for establishing and enhancing the creditworthiness of intellectual property.

Risen, Jr. et al. (U.S. 6,018,714) discloses a method of protecting against a change in value of intellectual property, and product providing such protection.

Salom (U.S. 2003/0167175) discloses a method and system for generating new business.

Reddy (U.S. 2002/0087446) discloses a method and system for interactively enabling investment opportunities for investors.

Prokoski (U.S. 2002/0046038) discloses a system and method for establishing value and financing of intellectual property.

Prokoski (U.S. 7,292,994) discloses a system and method for establishing value and financing of intellectual property.

Donner (U.S. 5,999,907) discloses an intellectual property audit system.

Ishii et al. (U.S. 2002/0165811) discloses an investment system and data transmitting/receiving method.

Wilkinson et al. (U.S. 2002/0099637) discloses an intellectual property investment process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. ZECHER whose telephone number is (571)270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
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